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| 10/657,524 | 09/08/2003 | Daryl S. Meredith | TN-3481 | 9167 |
| 7590 12/24/2008 | | | | |
| Adan Ayala, Esq. Black & Decker Inc. TW-199 701 E. Joppa Road Towson, MD 21286 | | | | |
| EXAMINER | | | | |
| DENTER, CLARK F | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3724 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/657,524

Applicant(s)

MEREDITH, DARYL S.

Examiner

Clark F. Dexter

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 17 and 18 is/are pending in the application.
4a) Of the above claim(s) 2-5 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 6-9, 17 and 18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 1, 2008 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 6-9, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the last paragraph of claim 1, the recitations in parentheses render the claims vague and indefinite as to what is being set forth, particularly since it is not clear as to whether these recitations are intended to be considered as part of the claimed invention; further, it is not clear as to what structure is being set forth by the last paragraph of claim 1 including references to "a first forwardmost edge of the blade" and "a second forwardmost edge of the blade".

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 6-9 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by European Publication 0 752 300 (hereafter EP '300).

EP '300 discloses a saw (e.g., see Figs. 1-13 and 21) with every structural limitation of the claimed invention including:

a base (e.g., 12) for supporting a workpiece;

a saw assembly (e.g., see col. 6, line 35 - col. 7, line 1) connected to the base, the saw assembly comprising a pivot arm, an upper blade guard (e.g., 18) connected to the pivot arm, a motor (e.g., 20) attached to the upper blade guard, and a blade (e.g., 16) driven by the motor, the saw assembly being movable between an upper position for not engaging the workpiece, and a lower position for engaging the workpiece (e.g., by the pivot located immediately below the motor 20 as viewed in Figure 1); and

a fence assembly attached to the base and disposed to one side of the blade, the fence assembly comprising

a fixed fence (e.g., 48) fixedly attached to the base and disposed on the one side of the blade,

a movable fence (e.g., 32) slidably connected to and removably connected to the fixed fence (e.g., as shown in Figure 5) and disposed on the one side of the blade, the movable fence being linearly movable horizontally relative to the fixed fence, the movable fence defining a first support plane, at least one of the fixed fence and the movable fence for contacting the workpiece, and

an auxiliary fence (e.g., the upper, reduced cross-section portion of component 40) disposed on the one side of the blade behind at least one of the fixed fence and the movable fence, the auxiliary fence being higher than the highest point on the fixed fence and defining a second support plane substantially parallel to the first support plane (e.g., as shown in Fig. 4), so that when the movable fence (e.g., 32) is removed, no portion of the fence assembly is above the fixed fence (e.g., 48) and in front of the second support plane, allowing the auxiliary fence to contact the workpiece (e.g., the auxiliary fence 40 is fully capable of contacting a workpiece when the movable fence 32 is removed);

wherein a first line extending from the auxiliary fence and substantially perpendicular to the second support plane contacts the movable fence (e.g., 32) at a contact point, and a second line extending substantially parallel to the second support plane (e.g., a vertically-extending second line extending parallel to the right side of the reduced cross-section portion of 40 as viewed in Fig. 4) from the fixed fence (e.g., 48) will intersect the first line,

wherein the blade fully cuts a substantially rectangular workpiece placed against the auxiliary fence and completely disposed within a first distance between the auxiliary fence and a first forwardmost edge of the blade, the first distance being longer than a

second distance between the fixed fence and a second forwardmost edge of the blade (e.g., as best understood, it appears that the saw disclosed in EP '300 meets the limitations set forth in this last paragraph such as when considered in terms of the workpiece disclosed therein).

First, it is noted that the recitations in the claims that are set forth in parentheses cannot be considered to be part of the claim and thus have not been referenced above.

Second, it is noted that various types of workpieces will meet this claim; for example, an irregular, but "substantially rectangular" shaped workpiece, a stepped "substantially rectangular" workpiece, a generally L-shaped "substantially rectangular" workpiece or the like, that includes a portion that rests on the workpiece support surface and another portion that extends to contact portion 40. It is emphasized that all of the above-described manipulations, including selection of workpiece configurations, can be performed without modifying the prior art device as disclosed in the prior art document, and thus are considered to be functional recitations of intended use of the prior art device.

Regarding claims 6-9, EP '300 discloses the saw with every structural limitation of the claimed invention as further defined including

[claim 6] wherein the fixed fence has a support surface (e.g., at 107);

[claim 7 (from 6)] wherein the support surface is substantially parallel to an upper surface of the base;

[claim 8 (from 6)] wherein the support surface is substantially perpendicular to the first support plane;

[claim 9] wherein the fixed fence has a surface (e.g., 63) which is substantially coplanar with the first support plane;

[claim 18] wherein the first and second lines intersect at the contact point.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over European Publication 0 752 300 (hereafter EP '300).

EP '300 discloses a saw with almost every structural limitation of the claimed invention but including first and second support planes as described above, but lacks the specific distance between these support planes being 1.65 inches. However, to make the distance 1.65 inches would be the mere discovery of the optimum or workable ranges within the general conditions of the prior art by routine experimentation and therefore obvious to one having ordinary skill in the art. It is emphasized that the saw of EP '300 could clearly be constructed of a size or scale wherein such a distance is provided given what is taught by the disclosure of EP '300.

Response to Arguments

8. Applicant's arguments filed October 1, 2008 have been fully considered but they are not persuasive.

Regarding applicant's arguments on page 5 of the response directed to the rejections under 35 USC 112, it is respectfully submitted that the rejections must be maintained. First, parentheses in the claims, other than the standard reasons such as enclosing numerals, etc., are not acceptable. Second, any subject matter within the parentheses cannot be considered to further define the claimed invention. Thus, it is respectfully submitted that any limitations that applicant would like to be considered as further defining the claimed invention should be without parentheses.

Regarding applicants efforts to further define the invention in terms of the workpiece, it should first be noted that the Examiner has not considered such to be improper and has not set forth any objections or rejections directed thereto. However, defining the invention in terms of the workpiece is only effective if it clearly translates into positively defining structure of the claimed device/apparatus. In the present application, the reference to the "substantially rectangular" workpiece remains broad and it is respectfully submitted that the prior art meets the claimed invention at least in the manner described in the prior art rejection above.

For at least these reasons, it is respectfully submitted that the prior art rejection must be maintained.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/
Primary Examiner, Art Unit 3724**

cfd
December 22, 2008